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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,723	10/30/2003	Jeffery Lynn Nish	46206.0008	7712
7590	04/18/2005		EXAMINER	
L. Grant Foster HOLLAND & HART LLP P.O. Box 8749 Denver, CO 80201			MEISLIN, DEBRA S	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/697,723	NISH, JEFFERY LYNN
Examiner	Art Unit	
Debra S Meislin	3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 February 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-4,6-8 and 16-22 is/are allowed.
- 6) Claim(s) 5,9,10,13-15 and 23-25 is/are rejected.
- 7) Claim(s) 11 and 12 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 February 2005 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

1. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, "one of the retaining members" lacks antecedent basis since claim 2 defines "a retaining member".

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 23 and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gilbert.

Note the movable sleeve "27" of Gilbert which is of sufficient length to cover the middle sections of the elongated members "26".

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-10, 13-15 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert in view of Osborn et al.

Gilbert discloses a retaining member "42" coupled to the sleeve preventing the sleeve from extending a distance away from the handle and the elongate members being connected together at their proximal ends. Gilbert discloses all of the claimed

subject matter except for the movable sleeve being electrically insulating, the tip forming a "straight-slot" screwdriver tip, and the elongate members being welded together at their proximal ends within the handle. Osborn et al discloses elongated members being welded together at their proximal ends within the handle, col. 2, line 25-29. Osborn et al further discloses an electrically insulating sleeve and the tip forming a "straight-slot" screwdriver tip. It would have been obvious to one having ordinary skill in the art to weld the elongated members of Gilbert within the handle to attach the elements together as taught by Osborn et al. It would have been obvious to one having ordinary skill in the art to form the sleeve of Gilbert as electrically insulating to prevent shock as taught by Osborn et al. It would have been obvious to one having ordinary skill in the art to form the tip of Gilbert as a "straight-slot" screwdriver tip to enable the engagement of a straight slot as taught by Osborn et al.

With respect to claim 13, "high" voltage is a relative term and dependent upon an unknown reference point. Note also, that a device using insulation is designed with the appropriate amount or type of insulation dependent upon the type of workpiece being worked upon.

6. Claims 11-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Claims 1-4, 6-8 and 16-22 are allowed.
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Applicant's arguments filed February 10, 2005 have been fully considered but they are not persuasive.

Applicant contends that claims 10 and 14-15 were not specifically addressed in the Office action. The examiner respectfully disagrees. At least claims 10 and 14-15 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. See paragraph 1 of the previous office action. The examiner had not indicated that these claims would have been allowable if the 35 U.S.C. 112 issues were addressed. To the contrary, the examiner had indicated that the claims which do not have art rejections applied thereto, if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, *In re Steele*, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (**it is improper to rely on speculative assumptions regarding the**

meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions). See paragraph 8 of the previous office action.

Applicant's arguments with respect to claims 1 and 6-8 are deemed moot in view of the indication of allowable subject matter.

Applicant's arguments with respect to claim 23 are deemed moot in view of the new grounds of rejection. Note the movable sleeve "27" of Gilbert which is of sufficient length to cover the middle sections of the elongated members "26".

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is some teaching, suggestion, or motivation to do so found in the references themselves. It would have been obvious to one having ordinary skill in the art to weld the elongated members of Gilbert within the handle to attach the elements together as taught by Osborn et al.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S Meislin whose telephone number is 571 272-4487. The examiner can normally be reached on M-F, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Debra S Meislin
Primary Examiner
Art Unit 3723

April 14, 2005